

CASE NO.: AM9-99-0122

Serial No.: 09/448,253

January 22, 2003

Page 2

PATENT

Filed: November 24, 1999

the data on protected CDs. Instead, it is a method by which CD-players can determine whether a particular CD is a legitimate original or an illicit copy. If legitimate, the player plays the CD normally. If not, the player shuts down..." Ryan, col. 2, lines 25-30. That is, Ryan does not use a signature match to prevent unauthorized recording - indeed, it explicitly teaches that such is not the point of its invention - but only to prevent playing illicit CDs.

With the above in mind, there is no prior art motivation to combine the references as proposed, since to do so would defeat the teaching of Ryan to erect a piracy wall not at the point of compression/recording but at the point of playing, see MPEP §2141.02 (prior art must be considered as a whole, including references that teach away). Indeed, the Office Action fails to identify the *prior art* suggestion to combine, but instead simply offers the unsupported observation that the proposed combination would achieve better security. However, a general observation of purported advantages in otherwise unconnected references does not suffice to meet the prima facie obviousness standards of the MPEP (see also MPEP §2143 et seq., emphasizing the requirement that the prior art suggest not just each reference individually but also the proposed combination). Where is the motivation for adding the alleged security features of Lane et al. to Ryan when, as here, Ryan already provides security by preventing playing of unauthorized disks?

More fundamentally, Lane et al. has been mischaracterized in the Office Action. Specifically, it is alleged that Lane et al. discloses preventing compression of data such as music in the absence of an authorized signature, referencing, without particularity, columns 2-6 of Lane, but nowhere do the words "digital" or "signature" appear in Lane et al.

Note further that the claims do not recite "signature" in a vacuum. Rather, the claims recite a signature that is derived from the data, e.g., the music, sought to be processed. Applicant has scoured the

1033-GLAM2

CASE NO.: AM9-99-0122

Serial No.: 09/448,253

January 22, 2003

Page 3

PATENT

Filed: November 24, 1999

five columns of Lane et al. purporting to show a "signature" in an effort to divine what the examiner might have been referring to but cannot find anything remotely approaching a "signature", much less one derived from the data sought to be compressed in Lane et al. Instead, the closest teaching in Lane et al. appears to be the tokens that are used to indicate whether to compress particular portions of the data stream. These tokens are not signatures, much less signatures that have been derived from anything, much less the data to be compressed in Lane et al. Certainly, there is no evidence on the record that the skilled artisan, in reading the present claims, would mistake a "token" for a "signature", much less the particular signature claimed, see MPEP §2111.01 (claims must be given the broadest reasonable interpretation that one skilled in the art would give them).

Likewise, it is a technically incorrect characterization that Pham et al., col. 3, lines 20-52 teaches storing an authorized digital signature on a disk apart from the stream, and also that this section of Pham et al. teaches signature dates useful for processing the data. Nowhere is the concept of signature date even mentioned in the relied-upon section of Pham et al. Instead, all the relied-on section teaches is that prior to converting data in a proprietary format to an industry standard format, the file is "unwrapped" and verified through a signature which was attached to the original wrapped file. The purpose is to allow the source (proprietary) system to recapture the files in their original formats, col. 3, lines 32-45. That is, Pham et al. uses digital signatures not for security but for conversion between file formats. This does not teach, nor does it necessitate, storing the signatures apart from the stream, since the signatures can be gotten any time and any place, with security not being a concern.

With the above in mind, it is perhaps not surprising that the Office Action offers no prior art suggestion to combine Pham et al., concerned with format-to-format conversions, with Ryan, concerned with

1053-66.AM2

CASE NO.: AM9-99-0122
Serial No.: 09/448,253
January 22, 2003
Page 4

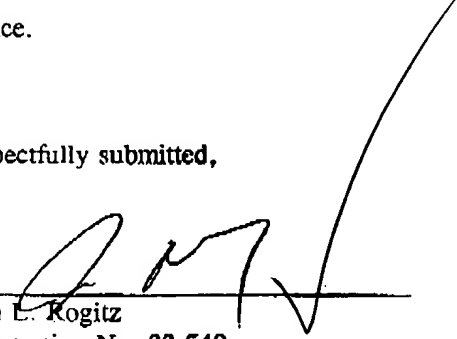
PATENT
Filed: November 24, 1999

preventing playing unauthorized disks, a completely different concept. Moreover, the unsupported statement in paragraph 29 of the Office Action that it would have been obvious to combine Pham et al. with Ryan simply to improve security cannot be derived from the references, since from the relied-upon section Pham et al. is not concerned with security at all. Still further, even if Pham et al. were to be combined with Ryan, the present invention would not be arrived at, since the combination would simply result in grafting Pham et al.'s file conversion technique onto Ryan's playback prevention technique.

The examiner's request that Applicant consider the entire references is noted. However, the burden is on the examiner to specify the best portions of the references being relied on, MPEP §706.02(j). Trying to divine what, in five columns, is being relied on for a particular proposition, much less "other passages and figures [that] may be applied as well", unfairly requires Applicant to hit a moving target and is not in compliance with the MPEP.

The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

Respectfully submitted,



John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

JLR:jg

1051-68.AM2